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10/035,932	12/26/2001	Rick L. Angell	31125US2	4466

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EXAMINER

MUSSER, BARBARA J

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/035,932

Applicant(s)

ANGELL ET AL.

Examiner

Barbara J. Musser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 22 and 23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-20 is/are rejected.
- 7) ☒ Claim(s) 12 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-21, drawn to a method of making a web of conductive filler, classified in class 156, subclass 200.
  - II. Claims 22 and 23, drawn to a forming station for making a web, classified in class 156, subclass 461.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to make a different product such as feminine napkins.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Robert Bodi on 8/13/03 a provisional election was made without traverse to prosecute the invention of group I, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22 and 23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "said unfinished filler" in lines 32, 33 and 35.

There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 14, it is unclear whether the claim is intended to contain additional material as the claim ends in a semi-colon, not a period.

Regarding claim 15, lines 8-10 are confusing. It is unclear if the unfinished filler is intended to be the conductive filler as two different terms are used but there appears to be no difference between their meanings in the claim.

Regarding claim 17, lines 8-10 are confusing. It is unclear if the unfinished filler is intended to be the conductive filler as two different terms are used but there appears to be no difference between their meanings in the claim.

Regarding claim 18, it is unclear whether the claim is intended to contain additional material as the claim ends in a semi-colon, not a period. It is unclear whether there are one or two webs of conductive material, as the claim states "a web of conductive layer". It is suggested this be changed to –a web of conductive material—as in the previous claims.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, 4, 6, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emery(U.S Patent 6,224,494) in view of the collective teachings of the state of the art as evidenced by at least one of Smith(U.S Patent 1,650,049), Middleton(U.S Patent 3,654,027) and Molins(U.S Patent 3,668,045).

Emery discloses a conductive filler wherein a nonconductive core is wrapped by a conductive tape which overlaps itself.(Col. 2, ll. 42-48; Figure 4B) The reference does not disclose how this filler is formed. However, the forming of product having a core surrounded by a covering layer is well-known in the bonding arts as shown for example by any of Smith(Figure 5), Middleton(Figure 6) and Molins(Figure 1) which show folding the edges of a web over a core and overlapping the edges to form a product having a core surrounded by a covering layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to fold the edges of the conductive tape of

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Emery around the core and overlap the edges since this is a well-known method of forming a product having a core surrounded by a covering layer as shown by the collective teachings of the state of the art as evidenced by at least one of Smith, Middleton, and Molins.

Regarding claims 2 and 4, Emery does not disclose whether the adhesive is on the interior or exterior of the conductive tape after it is wrapped around the core. One in the art would appreciate that the adhesive layer could be on either side depending on whether it was more important for the conductive tape to be bonded to the core or to the article it was placed in.

Regarding claim 6, it is well-known in the bonding arts to press layers together using roll pairs to bond them together as shown for example by Smith, which shows a roll pair pressing layers having adhesive between them together.(Figure 1) It would have been obvious to one of ordinary skill in the art at the time the invention was made to press the core and conductive layer together using a roll pair since the use of roll pairs to press layers having adhesive together is well-known in the art as shown for example by Smith.(Figure 1)

Regarding claim 9, Emery discloses the conductive layer is overlapped such that a portion of it forms a laminate.(Figure 4B)

Regarding claim 10, while Emery discloses an adhesive tape, i.e. a continuous web of adhesive, using adhesive strips only in the joining region is an obvious alternative as shown for example by Molins which discloses applying adhesive to the edges only.(Figure 2) It would have been obvious to one of ordinary skill in the art at

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the time the invention was made to apply adhesive to only the edges of the conductive layer since the use of adhesive only in specific locations is an obvious alternative as shown for example by Molins.(Figure 2) While the reference discloses applying adhesive as a coating, the use of webs of adhesive is rather than coatings is a well-known alternative in the bonding arts. Only the expected results would be achieved.

10. Claims 3, 5, 7, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emery and the collective teachings of the state of the art as evidenced by at least one of Smith, Middleton, and Molins as applied to claims 1, 2, 6, and 10 above, and further in view of Onai(U.S. Patent 4,889,963).

The references cited above are silent as to the specifics of the conductive tape. Onai discloses an flexible electrically conductive sheet which allows current to be discharged through it.(Col. 2, ll. 43-54) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the conductive sheet of Onai as the backing for the tape of Emery since the sheet of Onai can pass and discharge current(Col. 2, ll. 53-55) which is the purpose of the conductive filler of Emery.

Regarding claim 8, Emery discloses the conductive layer is overlapped such that a portion of it forms a laminate.(Figure 4B)

11. Claims 1, 2, 4, 6, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delon(U.S Patent 1,740,076) in view of the collective teachings of the state of the art as evidenced by at least one of Smith, Middleton, and Molins.

Delon discloses a conductive filler wherein a nonconductive core is wrapped by a conductive layer which overlaps itself.(Pg. 1, ll. 14-18, 58-65; Figure 1) The reference

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does not disclose how this filler is formed. However, the forming of product having a core surrounded by a covering layer is well-known in the bonding arts as shown for example by any of Smith(Figure 5), Middleton(Figure 6) and Molins(Figure 1) which show folding the edges of a web over a core and overlapping the edges to form a product having a core surrounded by a covering layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to fold the edges of the conductive layer of Delom around the core and overlap the edges since this is a well-known method of forming a product having a core surrounded by a covering layer as shown by the collective teachings of the state of the art as evidenced by at least one of Smith, Middleton, and Molins.

Regarding claims 2 and 4, Delon is silent as to the presence or absence of adhesive bonding the layers together. The use of adhesives to hold items in place is well-known in the general. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply adhesive to the inside and outside of the conductive layer of Delon since this would hold the conductive layer in place on the core and since this would hold the conductive layer in place relative to the cables it is adjacent to.

Regarding claim 6, it is well-known in the bonding arts to press layers together using roll pairs to bond them together as shown for example by Smith, which shows a roll pair pressing layers having adhesive between them together.(Figure 1) It would have been obvious to one of ordinary skill in the art at the time the invention was made to press the core and conductive layer together using a roll pair since the use of roll



pairs to press layers having adhesive together is well-known in the art as shown for example by Smith.(Figure 1)

Regarding claim 9, Delon discloses the conductive layer is overlapped such that a portion of it forms a laminate.(Figure 1)

Regarding claim 10, while Delon is silent as to the presence or absence of adhesive, the use of adhesive to hold things in position is well-known in general. It would have been obvious to one of ordinary skill in the art at the time the invention was made to adhesive strips only in the joining region as shown for example by Molins which discloses applying adhesive to the edges only(Figure 2) since this would hold the conductive layer in place while using a minimal amount of adhesive. While the reference discloses applying adhesive as a coating, the use of webs of adhesive is rather than coatings is a well-known alternative in the bonding arts. Only the expected results would be achieved.

12. Claims 3, 5, 7, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delon and the collective teachings of the state of the art as evidenced by at least one of Smith, Middleton, and Molins as applied to claims 1, 2, 6, and 10 above, and further in view of Onai.

The references cited above disclose the conductive layer can be made from paper(fiber) rendered conductive in some manner.(Pg. 1, ll. 53-58) Onai discloses an flexible electrically conductive sheet which allows current to be discharged through it.(Col. 2, ll. 43-54) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the conductive sheet of Onai as the conductive

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layer of Delon since the sheet of Onai can pass and discharge current(Col. 2, ll. 53-55) which is the purpose of the conductive filler of Delon.

Regarding claim 8, Delon discloses the conductive layer is overlapped such that a portion of it forms a laminate.(Figure 1)

### ***Allowable Subject Matter***

13. Claims 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 14-20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

15. Claim 21 is allowed.

16. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or fairly suggest placing separate adhesive webs on the edges of a conductive layer on the same side, and then folding the layer around a filler such that one adhesive web contacts the filler and the other contacts the conductive layer in the context of the claimed invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Barbara J. Musser** whose telephone number is (703)-

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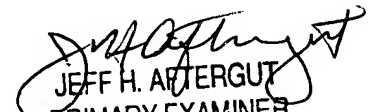
**305-1352.** The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



BJM



JEFF H. AFTERGUT  
PRIMARY EXAMINER  
GROUP 1300